

III. Remarks

Claims 27-30 have been withdrawn and claims 1-26 have been maintained in their original form.

Claims 1-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over King in view of Simpson et al. It is requested that the examiner reconsider this rejection for the following reasons.

Claim 1 recites the unique combination of a cylinder having a circumference substantially equal to twice the length of each shingle to be cut; a cutting blade assembly extending around the outer surface of the cylinder and adapted to cut four different patterns in the strip with each pattern forming two shingles; and means for rotating the cylinder with the blades engaging the sheet while effecting relative translational movement between the cylinder and the sheet so that eight shingles are cut from the sheet upon one rotation of the cylinder.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

Here, the examiner clearly cannot establish a *prima facie* case of obviousness in connection with claim 1 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, King and Simpson et al., alone, or in combination, do not teach a cylinder having a circumference substantially equal to twice the length of each shingle to be cut; a cutting blade assembly extending around the outer surface of the cylinder and adapted to cut four different patterns in the strip with each pattern forming two shingles; and means for rotating the cylinder with the blades engaging the sheet while effecting relative translational movement between the cylinder and the sheet so that eight shingles are cut from the sheet upon one rotation of the cylinder.

Rather, King is limited to a series of cutting cylinders 30, 72, 84, and 94 and therefore does not teach a cylinder having a circumference substantially equal to twice the length of each shingle to be cut, a cutting blade assembly extending around the outer surface of the cylinder and adapted to cut four different patterns in the strip with each pattern forming two shingles; and means for rotating the cylinder with the blades engaging the sheet while effecting relative translational movement between the cylinder and the sheet so that eight shingles are cut from the sheet upon one rotation of the cylinder.

Simpson is limited to a cylinder 12 having an assembly 29 of metal die rule members and does not teach a cylinder having a circumference substantially equal to twice the length of each shingle to be cut, a cutting blade assembly extending around the outer surface of the cylinder and adapted to cut four different patterns in the strip with each pattern forming two shingles; and means for rotating the cylinder with the blades engaging the sheet while effecting relative translational movement between the cylinder and the sheet so that eight shingles are cut from the sheet upon one rotation of the cylinder.

Moreover, given the above deficiencies in each of the King and Simpson patents, it is apparent that it would be impossible to combine them in any manner, including the manner set forth by the examiner, to meet all of the limitations of claim 1.

Therefore, it is impossible to render the subject matter of claim 1 as a whole obvious based on any combination of these patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the King and Simpson et al. patents cannot be combined and applied to reject claim 1 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that

person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, King and Simpson et al. do not teach, or even suggest, the desirability of the combination since neither teaches or suggests providing a cylinder having a circumference substantially equal to twice the length of each shingle to be cut; a cutting blade assembly extending around the outer surface of the cylinder and adapted to cut four different patterns in the strip with each pattern forming two shingles; and means for rotating the cylinder with the blades engaging the sheet while effecting relative translational movement between the cylinder and the sheet so that eight shingles are cut from the sheet upon one rotation of the cylinder.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 1.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)


In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1, and the rejection under 35 U.S.C. §103(a) is not applicable.

Previously presented independent claim 14 is a method version of claim 1, and therefore is allowable for the reasons indicated above. Dependent claims 2-13 and 15-26 depend from, and further limit, independent claims 1 and 14, respectively, in a patentable sense and therefore are allowable as well.

In view of all of the above, the allowance of claims 1-26 is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

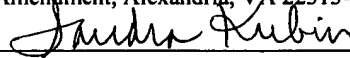
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